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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,445	06/26/2003	Shuichi Sugita	2204-031174	2951

28289 7590 09/20/2005

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EXAMINER
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KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/606,445

Applicant(s)

SUGITA ET AL.

Examiner

Kevin R. Kruer

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/29/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed June 30, 2005 has been fully considered and an initialed copy of said PTO-1449 is enclosed herein.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are drawn to a laminate wherein the light reflected from the base metal sheet is "substantially the same" as the light reflected from the base metal sheet having a clear paint film or clear paint film in combination with an under clear coat and/or top coat. It is not clear how the term "substantially the same" should be interpreted.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for reasons of record.

The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is

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most nearly connected, to make and/or use the invention. The claims are drawn to a laminate wherein "the light reflected from the base metal sheet is substantially the same as the light reflected from the base metal sheet having a clear paint film or clear paint film in combination with an under clear coat and/or top coat." Said laminate comprises an interference coloring pigment in the clear paint film (claim 1) that give the laminate an interference coloring effect. However, the prior art (US 4,615,940) suggests that the interference coloring effect cannot be obtained with a non-pigmented clear-paint film. Specifically, '940 teaches that the paint film must have a color value of N-4 to N-8 on the Munsell color chart (col 5, lines 20+) in order for opalescent effected to be perceptible (col 5, lines 35+). Thus, it is unclear how applicant is able to obtain said interference coloring effect outside the color value ranges disclosed to be critical by the prior art.

6. Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear from applicant's response where the original disclosure contains support for the newly added limitation that the laminate is such that "the light reflected from the base metal sheet is substantially the same as the light reflected from the base metal sheet having a clear paint film or clear paint film in combination with an under clear coat and/or top coat."

### ***Response to Arguments***

Applicant's arguments filed June 30, 2005 have been fully considered but they are not persuasive.

Applicant argues the term "substantially the same" would be understood by one of ordinary skill in the art to mean "a value within 95%, plus or minus" of the value of the light reflected off the base metal sheet. Said argument is noted, but said interpretation of the phrase "substantially the same" is not supported by the original disclosure. Furthermore, there is no evidence that one of ordinary skill in the art would have necessarily interpreted said phrase to mean "a value within 95%, plus or minus."

The rejection of the claims under 112, second paragraph as being indefinite because it was unclear how brightness was measured has been overcome. On page 16 (lines 12-13) of the specification, Applicant discloses a method of measuring brightness using a spectrum colorimeter.

With regard to the enablement rejection of claims 1-9, Applicant argues the color values of Panush are a property of the base coat paint, a base coat that contains a conventional pigment whereas the clear paint film of the present invention does not include conventional pigments in the amounts disclosed by Panush. Applicant argues the claimed invention provides color through the use of oxide coated flakes and the color is controlled by the thickness of the oxide layers. Applicant argues, therefore, the Munsell color values of Panush are irrelevant to the present invention. The examiner respectfully disagrees. Panush teaches the interference coloring effect cannot be obtained with a non-pigmented clear-paint film. Specifically, '940 teaches that the paint film must have a color value of N-4 to N-8 on the Munsell color chart (col 5, lines 20+) in

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order for opalescent effected to be perceptible (col 5, lines 35+). Panush teaches the Munsell color value of the paint film is critical to obtain an opalescent effect, contrary to Applicant's claim that Panush teaches (at column 8, lines 23-25) exactly how to obtain the interference coloring effect regardless of the Munsell value of the paint film.

Furthermore, if Panush teaches exactly how to obtain the interference coloring effect regardless of the Munsell value of the base coat (as Applicant has argued), it would seem as if Panush teaches one of ordinary skill in the art how to make the claimed invention.

For the reasons noted above, the rejections are maintained.

### ***Conclusion***

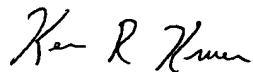
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R. Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kevin R. Kruer  
Patent Examiner-Art Unit 1773